



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,148	02/08/2001	David Charles Lyons	12929.1053US01	7450

23552 7590 09/10/2003
MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

YOON, TAE H

ART UNIT	PAPER NUMBER
1714	7

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/781,148	LYONS ET AL.	
Examiner	Art Unit	1714	
Tae H Yoon			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
 - 4a) Of the above claim(s) 1-29 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 30-39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

Claims 30-39 are examined and the restriction requirement proposed by Examiner Lechert, Jr. is attached at the end of the office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The examiner's position is that the recited "25 % or less by wt. Inorganic fiber" of claim 30 encompasses 0%, and an overlapping range of the prior art is an anticipation as well as a prima facie obviousness.

Claims 30-33 and 35-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bennett (US 4,229,329).

Bennett teaches the instant composition in examples 1-9 and claims 1-7. For example, example 2 having 2-6% of sodium silicate and 2-6% of silica and example 9

having 28-32% of silica meet the claim 31, and UCAR Latex 5000 of example 6 meets the claim 30. Also, example 9 having 0.3-0.6% of Cellosize 15000 (organic polymer), 10-13% of UCAR Latex 5000 (binder) and 28-32% of silica (inorganic filler) meet the claim 32 and 33. Cellosize 15000 (hydroxyethyl cellulose (organic polymer) and a thickener) is taught at col. 3, lines 42-48. Thus, the instant invention lacks novelty.

Claims 30 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bafford et al (US 4,746,565).

Bafford et al teach the instant composition in example 1. Thus, the instant invention lacks novelty.

Claims 30-32 and 36-39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Andersen et al (US 6,090,195).

Andersen et al teach the instant composition in claim 1 wherein a composition comprising 10-80% of water, 5-80% of an organic binder, 20-90% of inorganic aggregate and a fiber is taught. Also, said inorganic aggregate such as silica of claim 8 meets the instant claim 31. Inorganic fiber is taught in claim 23. Claim 41 also meets the instant invention. Thus, the instant invention lacks novelty.

Claims 30-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jain (US 4,839,222).

Jain teaches an aqueous composition having a solid content of 30-75% comprising 6-26% of a vinyl polymer, 40-80% of inorganic filler and 0.2-2% of a thickening agent in claim 1. Said vinyl polymer taught in claim 2 meets the instant binder, and said thickening agent taught in claim 13 meets the instant claims 33-35. Also, said inorganic filler such as clay of claim 1 meets the instant inorganic binder of claim 31 as well as claim 32. Thus, the instant invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tae H Yoon
Primary Examiner
Art Unit 1714

Thy/September 4, 2003

Art Unit: 1732

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a method, classified in class 264, subclass 109.
 - II. Claims 23-29, drawn to an article, classified in class 428, subclass 34.1+.
 - III. Claims 30-39, drawn to a polymeric composition, classified in class 523, subclass 138.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, III are related as process of making and product made and the composition of the material. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the hollow container article firebox could be made by conventional shaping such as by extruding a monolithic structure or the hollow container can be made by centrifugal casting. The method of compression molding of materially different compositions can be accomplished by the method and does not require the composition of the group III claims.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1732

4. Because these inventions are distinct for the reasons given above and the search required for any one Group is not required for the other groups, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mr. Doscotch on August 18, 2003 a provisional election was made with traverse to prosecute the invention of the group III, the composition, and claims 30-39. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-29 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Lechert Jr. whose telephone number is 703-305-6156. The examiner can normally be reached on 9:30-6:00.
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P Colaianni can be reached on 703-305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1732

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.

Stephen J. Lechert Jr. *SL*

Primary Examiner

Art Unit 1732